

EXHIBIT A

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FORESCOUT TECHNOLOGIES, INC.

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

FORTINET, INC.,
Plaintiff,
v.
FORESCOUT TECHNOLOGIES, INC.,
Defendant

CASE NO. 3:20-CV-03343-EMC

DEFENDANT FORESCOUT TECHNOLOGIES, INC.'S INVALIDITY CONTENTIONS PURSUANT TO LOCAL PATENT RULES 3-3 AND 3-4

1 **I. INTRODUCTION**

2 Pursuant to the Fed. R. of Civ. Proc. and this Court's Patent L.R. 3-3 and 3-4, Defendant
 3 Forescout Technologies, Inc. ("Forescout" or "Defendant") serves these Invalidity Contentions on
 4 Plaintiff Fortinet, Inc. ("Fortinet" or "Plaintiff") for United States Patent Nos. 9,369,299 (the "299
 5 Patent"); 8,458,314 (the "314 Patent"); and 9,948,662 (the "662 Patent") (collectively, the "Asserted
 6 Patents"). These Invalidity Contentions are based on Forescout's current knowledge of the Asserted
 7 Patents and prior art, along with its understanding of Fortinet's infringement allegations set forth in
 8 Fortinet's August 27, 2020 Disclosure of Asserted Claims and Infringement Contentions
 9 ("Infringement Contentions"). Based on Fortinet's Infringement Contentions, Fortinet is asserting the
 10 following claims against Forescout (collectively, the "Asserted Claims"):

Patent	Asserted Claim(s)
The '299 Patent	1, 3–8, 10–16, and 18–21
The '314 Patent	1–13, 15–18, and 20
The '662 Patent	1–2, 5–7, 9–10, and 13–15

16 Forescout submits these Invalidity Contentions without waiving any arguments about the
 17 sufficiency or substance of Fortinet's Infringement Contentions, and without waiving any challenges
 18 to Fortinet's apparent claim constructions. Based in whole or in part on the claim interpretations that
 19 Fortinet appears to be asserting, and its alleged application of those interpretations to the accused
 20 products, Forescout contends that each cited prior art reference listed below anticipates or renders
 21 obvious the Asserted Claims, as described below and in the associated claim charts, attached hereto
 22 and incorporated by reference as if fully set forth herein.

23 Identifying these items of prior art and other defenses in connection with these Invalidity
 24 Contentions does not serve as an admission, or waiver of any argument or position refuting, that any
 25 alleged "Accused Product," including any current or past version of any alleged "Accused Product,"
 26 is covered by, or infringes any of the Asserted Claims (or any other claims of the Asserted Patents),
 27 particularly when the Asserted Claims are properly construed. Further, Forescout's Invalidity
 28 Contentions should not be construed as an admission regarding the proper construction of any asserted

1 claim, should not be deemed to represent or limit the claim constructions that Forescout will advance
 2 in this action, and should not be deemed to relate to the non-infringement positions Forescout may
 3 advance in this action.

4 Forescout's Invalidity Contentions reflect Forescout's current knowledge and contentions as
 5 of this early date in this action. Forescout's Invalidity Contentions are based in whole or in part on its
 6 present understanding of the Asserted Claims and Fortinet's apparent position as to the scope of the
 7 Asserted Claims as applied in its Local Patent Rule 3-1 disclosure. Accordingly, Forescout's
 8 Invalidity Contentions (including the attached invalidity claim charts) reflect, to the extent possible,
 9 Fortinet's expected alternative and potentially inconsistent positions as to claim construction and claim
 10 scope.

11 Forescout reserves the right, to the extent permitted by the Court and the applicable statutes
 12 and rules, to modify and supplement, without prejudice, these Invalidity Contentions. In addition,
 13 Forescout reserves the right, to the extent permitted by the Court and the applicable statutes and rules,
 14 to raise additional prior art and invalidity defenses not included in these Invalidity Contentions,
 15 including those based on additional discovery or other issues raised by Fortinet in this action or any
 16 related action. Forescout further reserves the right, to the extent permitted by the Court and the
 17 applicable statutes and rules, to amend these Invalidity Contentions should, for example, Fortinet
 18 provide any information that it failed to provide in its Initial Disclosures and/or its Infringement
 19 Contentions.

20 Further, because discovery has only recently begun, Forescout reserves the right, to the extent
 21 permitted by the Court and the applicable statutes and rules, to revise, amend, and/or supplement the
 22 information provided herein, including identifying and relying on additional prior art references should
 23 Forescout's further search and analysis yield additional information or references, consistent with the
 24 Local Patent Rules and the Federal Rules of Civil Procedure. Forescout expressly reserves the right,
 25 to the extent permitted by the Court and the applicable statutes and rules, to rely on witness testimony
 26 about the prior art references identified below to supplement these Invalidity Contentions, where
 27 appropriate. Moreover, Forescout reserves the right, to the extent permitted by the Court and the
 28 applicable statutes and rules, to revise its ultimate Invalidity Contentions concerning the invalidity of

1 the Asserted Claims, which may change depending upon the Court's construction of the Asserted
 2 Claims, any findings as to the priority date of the Asserted Claims, and/or positions that Fortinet or its
 3 fact or expert witness(es) may take concerning claim construction, infringement, and/or invalidity
 4 issues.

5 The accompanying invalidity claim charts list specific examples of where prior art references
 6 disclose, either expressly or inherently, each limitation of the Asserted Claims and therefore anticipate
 7 the claim and/or examples of disclosures in view of which a person of ordinary skill in the art at the
 8 time each of the alleged inventions was made, would have considered each limitation, and therefore
 9 the claim as a whole, obvious. The references, however, may contain additional support upon which
 10 Forescout may rely that is not specifically identified in these contentions. The citations included in
 11 each chart are illustrative, not exhaustive. For any given quotation or excerpt, for example, Forescout
 12 expressly reserves the right to introduce other text and images (including but not limited to
 13 surrounding, related, or explanatory text, images, or un-cited portions of the prior art references) from
 14 the same or other prior art references that may help to provide context to the quotation or excerpt.
 15 Furthermore, where Forescout cites to a particular figure in a reference, the citation should be
 16 understood to encompass the caption and description of the figure and any text relating, in any manner,
 17 to the figure. Similarly, where Forescout cites to particular text referring to a figure, the citation should
 18 be understood to include the corresponding figure as well. Forescout may also rely on other documents
 19 and information, including cited references and prosecution histories for the Asserted Patents or
 20 related patents (including but not limited to patents and/or patent applications, within the same family
 21 or at any time assigned to Fortinet), and witness testimony, including expert testimony, to explain,
 22 amplify, illustrate, demonstrate, provide context or aid in understanding the cited portions of the
 23 references.

24 II. P.R. 3-3(A): IDENTIFICATION OF PRIOR ART

25 Pursuant to Local Patent Rule 3-3, and subject to Forescout's reservation of rights, Forescout
 26 contends that one or more Asserted Claims of the Asserted Patents are anticipated or rendered obvious
 27 by the prior art identified below and as reflected in the attached Exhibits (A-1–A-7, B-1–B-4, and C-
 28 1–C-5). Forescout also contends that the Accused Products do not infringe any Asserted Claim of any

1 Asserted Patent.

2 Forescout reserves the right, to the extent permitted by the Court and the applicable statutes
 3 and rules, to assert that the Asserted Claims are invalid under pre-AIA 35 U.S.C. § 102(f) in the event
 4 Forescout obtains additional evidence that the named inventors of the Asserted Patents did not invent
 5 (either alone or in conjunction with others) the subject matter claimed in the Asserted Patents. Should
 6 Forescout obtain such evidence, it will provide the name of the person(s) from whom, and the
 7 circumstances under which, the invention or any part of it was derived.

8 Forescout further intends to rely on admissions of the named inventors and Fortinet concerning
 9 the prior art, including statements found in the Asserted Patents, their prosecution histories, and/or
 10 other related patents or patent applications, any deposition testimony, and the papers filed and any
 11 evidence submitted by Fortinet in conjunction with this action.

12 Finally, Forescout may rely on testimony from the authors or named inventors listed on the
 13 below references.

14 The following patents and patent publications are prior art to the Asserted Patents under at
 15 least pre-AIA 35 U.S.C. §§ 102(a), (b), (e), and/or (g) or post-AIA 35 U.S.C. § 102(a)(1) and/or (2).

<u>Table A-1</u>		
<u>Chart(s)</u>	<u>Country/Patent Number</u>	<u>Publication/Issue Date</u>
B-1, B-2, B-3, B-4	U.S. Patent No. 7,054,944 (“Tang”)	May 30, 2006
C-2	U.S. Patent No. 7,331,061 (“Ramsey”)	February 12, 2008
A-1, A-2, A-3, A-4	U.S. Patent No. 7,437,755 (“Farino”)	October 14, 2008
B-1, B-2, B-3, B-4	U.S. Patent No. 7,463,590 (“Mualem”)	December 9, 2008
A-1, A-2, A-3, A-4	U.S. Patent No. 7,703,126 (“Khosravi”)	April 20, 2010
A-2, A-3, A-4	U.S. Patent No. 7,853,687 (“Le Moigne”)	December 14, 2010
B-1, B-2, B-3, B-4	U.S. Patent No. 7,874,006 (“Hassan”)	January 18, 2011
A-1, A-2,	U.S. Patent No. 7,882,538 (“Palmer”)	February 1, 2011

Table A-1

Chart(s)	Country/Patent Number	Publication/Issue Date
A-3, A-4		
B-1, B-2, B-3, B-4	U.S. Patent No. 7,904,558 (“Malik”)	March 8, 2011
A-2, A-3, A-4	U.S. Patent No. 7,921, 686 (“Bagepalli”)	April 12, 2011
B-1, B-2, B-3, B-4	U.S. Patent No. 7,925,729 (“Bush”)	April 12, 2011
C-1, C-2, C-3	U.S. Patent No. 8,116,243 (“Zhiying”)	February 14, 2012
B-1, B-2, B-3, B-4	U.S. Patent No. 8,125,927 (“Nandy”)	February 28, 2012
B-1, B-2, B-3, B-4	U.S. Patent No. 8,406,140 (“Halbert”)	March 26, 2013
A-1, A-2, A-3, A-4	U.S. Patent No. 8,520,512 (“Gilde”)	August 27, 2013
B-1, B-2, B-3, B-4	U.S. Patent No. 8,543,665 (“Ansari”)	September 24, 2013
A-1, A-2, A-3, A-4	U.S. Patent No. 8,544,058 (“Lim”)	September 24, 2013
A-1, A-2, A-3, A-4	U.S. Patent No. 8,549,584 (“Singh”)	October 1, 2013
A-1, A-2, A-3, A-4	U.S. Patent No. 8,549,585 (“Dhanakshirur”)	October 1, 2013
A-1, A-2, A-3, A-4	U.S. Patent No. 8,590,004 (“Comay ’004”)	November 19, 2013
A-2	U.S. Patent No. 9,027,079 (“Comay ’079”)	May 5, 2015
A-2	WIPO Patent Application WO 2008/099402 (“Comay ’402”)	August 21, 2008
A-2, A-3, A-4	U.S. Patent No. 8,639,800 (“Friedrich ’800”)	January 28, 2014
A-3	WIPO Patent Application WO 2008/099403 (“Friedrich ’403”)	August 21, 2008
A-1, A-2, A-3, A-4	U.S. Patent No. 8,972,589 (“Roesel”)	March 3, 2015
B-1, B-2, B-3, B-4	U.S. Patent No. 9,077,611 (“Cordray”)	July 7, 2015

Table A-1

<u>Chart(s)</u>	<u>Country/Patent Number</u>	<u>Publication/Issue Date</u>
C-1, C-2, C-3	U.S. Patent No. 9,628,442 (“Zhu”)	April 18, 2017
C-1, C-2, C-3	U.S. Patent No. 10,257,161 (“L.”)	April 9, 2019
B-4	U.S. Patent Application Pub. No. 2003/0115292 (“Griffin”)	June 19, 2003
B-1, B-2, B-3, B-4	U.S. Patent Application Pub. No. 2005/0081063 (“Patrick”)	April 14, 2005
A-1, A-2, A-3, A-4	U.S. Patent Application Pub. No. 2005/0278542 (“Pierson”)	December 15, 2005
A-1, A-2, A-3, A-4, B-1, B-2, B-3, B-4	U.S. Patent Application Pub. No. 2007/0143629 (“Hardjono”)	June 21, 2007
B-1, B-2, B-3, B-4	U.S. Patent Application Pub. No. 2007/0192500 (“Lum ’500”)	August 16, 2007
A-1, A-2, A-3, A-4, B-1, B-2, B-3, B-4	U.S. Patent Application Pub. No. 2007/0192858 (“Lum ’858”)	August 16, 2007
B-1, B-2, B-3, B-4	U.S. Patent Application Pub. No. 2007/0208857 (“Danner”)	September 6, 2007
C-1, C-2, C-3	U.S. Patent Application Pub. No. 2014/0215580 (“Behringer”)	July 31, 2014
A-5	U.S. Patent No. 8,234,705 (“Roskind”)	July 31, 2012

The following non-patent publications are prior art to the Asserted Patents under at least pre-AIA 35 U.S.C. §§ 102(a), (b), and/or (g) or post-AIA 35 U.S.C. § 102(a)(1).

Table A-2

<u>Chart(s)</u>	<u>Title</u>	<u>Publication Date</u>	<u>Author(s) / Publisher</u>
B-1, B-2, B-3, B-4	SSL-Explorer: Administrators Guide Version 0.2.10 (“SSL-Explorer Guide”)	2006	3SP Ltd.
B-1, B-2, B-3, B-4	Barracuda SSL VPN Administrator’s Guide Version 1.0 (“Barracuda SSL	2008	Barracuda Networks

Table A-2

<u>Chart(s)</u>	<u>Title</u>	<u>Publication Date</u>	<u>Author(s) / Publisher</u>
	VPN Guide”)		
C-1	HP TippingPoint Local Security Manager User’s Guide TOS Version 3.6 (“HP TippingPoint Guide”)	October 2013	Hewlett-Packard Development Company, L.P.
A-7, C-5	CounterACT Console User Manual for Version 6.2 (“CounterACT 6.2 Manual”)	2007	Forescout
C-4	CounterACT Console User Manual Version 7.0.0 (“CounterACT 7 Manual”)	2012	Forescout
A-6	Cisco NAC Appliance – Clean Access Manager Installation and Administration Guide Release 4.1 (“Cisco NAC Guide”)	December 2006	Cisco

The following items, on information and belief, were publicly used, publicly known, offered for sale, and/or sold, and are therefore prior art to the Asserted Patents under at least pre-AIA 35 U.S.C. §§ 102(a), (b), and/or (g) or post-AIA 35 U.S.C. § 102(a)(1).

Table A-3

<u>Chart(s)</u>	<u>Title</u>	<u>Date of Public Knowledge, Use, Offer for Sale and/or Sale</u>	<u>Author(s) / Publisher</u>
B-1, B-2, B-3, B-4	SSL-Explorer	2006	3SP Ltd.
B-1, B-2, B-3, B-4	Barracuda SSL VPN	2008	Barracuda Networks
C-1	HP TippingPoint	October 2013	Hewlett-Packard Development Company, L.P.
A-7, C-5	CounterACT 6.2	2007	Forescout
C-4	CounterACT 7	2012	Forescout
A-6	Cisco NAC	December 2006	Cisco

Moreover, the following references illustrate the state of the art as of Fortinet’s claimed priority

1 dates, along with any references cited or otherwise referred to in these references or any applications
 2 (including provisional applications) to which these references claim priority:

- 3 • U.S. Patent No. 8,555,341
- 4 • U.S. Patent No. 8,156,558
- 5 • U.S. Patent No. 7,814,542
- 6 • U.S. Patent No. 7,672,283
- 7 • U.S. Patent Application Pub. No. 2006/0123133
- 8 • U.S. Patent Application Pub. No. 2010/0011094
- 9 • U.S. Patent No. 9,917,783

10 **III. P.R. 3-3(b): PRIOR ART THAT ANTICIPATES OR RENDERS OBVIOUS ONE OR
 11 MORE ASSERTED CLAIMS**

12 Subject to Forescout's reservation of rights, Forescout identifies the prior art that anticipates
 13 the Asserted Claims in its Exhibits A-1–A-7 ('299 Patent), B-1–B-4 ('314 Patent), and C-1–C-5 ('662
 14 Patent).

15 In the attached charts and below, Forescout identifies the following combinations of prior art
 16 now known to Forescout that render obvious one or more of the Asserted Claims under 35 U.S.C.
 17 § 103. Forescout also discloses the motivation to combine such items. Forescout reserves the right to
 18 assert that any of the identified prior art anticipates one or more of the Asserted Claims under pre-AIA
 19 35 U.S.C. § 102 depending upon the Court's construction of the Asserted Claims, any findings as to
 20 the priority date of the Asserted Claims, and/or positions that Fortinet or its fact or expert witness(es)
 21 may take concerning claim construction, infringement, and/or invalidity issues.

22 **A. Exemplary Combinations**

23 **1. Exemplary Combinations re the '299 Patent (Charts A-1 – A-6)**

24 As disclosed in Forescout's Charts A-2 and A-3, a Person of Ordinary Skill in the Art
 25 ("POSITA") would be motivated to combine Comay '004 and Friedrich '800, which both share the
 26 same assignee, based at least on the similarity of their descriptions.

27 As disclosed in Forescout's charts A-1 through A-6, a POSITA would be motivated to

1 combine Palmer, Comay '004, Friedrich '800, Pierson, Roskind, or Cisco NAC with one or more of
 2 the following references: Farino, Khosravi, Le Moigne, Palmer, Bagepalli, Gilde, Lim, Singh,
 3 Dhanakshirur, Comay '004, Friedrich '800, Roes, Pierson, Hardjono, or Lum '858. As disclosed
 4 for specific limitations in each of charts A-1 through A-6, these references are relevant to certain
 5 features that were well understood in the prior art, and a POSITA would have been motivated to
 6 make the combinations identified within the charts.

7 **2. Exemplary Combinations re the '314 Patent (Charts B-1 – B-4)**

8 As disclosed in Forescout's Charts B-2 and B-3, a POSITA would be motivated to combine
 9 SSL-Explorer and Barracuda SSL VPN based on least on the similarity of their descriptions and the
 10 use of identical descriptions/graphics in certain parts of each respective guide.

11 As disclosed in Forescout's charts B-1 through B-4, a POSITA would be motivated to
 12 combine Patrick, SSL Explorer, Barracuda SSL VPN, or Griffin with one or more of the following
 13 references: Tang, Mualem, Hassan, Malik, Bush, Nandy, Halbert, Ansari, Cordray, Patrick,
 14 Hardjono, Lum '500, Lum '858, or Danner. As disclosed for specific limitations in each of charts B-
 15 1 through B-4, these references are relevant to certain features that were well understood in the prior
 16 art, and a POSITA would have been motivated to make the combinations identified within the
 17 charts.

18 **3. Exemplary Combinations re the '662 Patent (Charts C-1 – C-5)**

19 As disclosed in Forescout's charts C-1 through C-3, a POSITA would be motivated to
 20 combine HP TippingPoint, Ramsey, or Behringer with one or more of the following references:
 21 Zhiying, Zhu, L, or Behringer. As disclosed for specific limitations in each of charts C-1 through C-
 22 5, these references are relevant to certain features that were well understood in the prior art, and a
 23 POSITA would have been motivated to make the combinations identified within the charts.

24 **B. Motivations to Combine**

25 The Asserted Claims do not represent innovation over the prior art, but instead would be no
 26 more than the result of ordinary skill and common sense. No showing of a specific motivation is
 27 required to combine the prior art (including the references disclosed above), as each combination
 28 would not have produced unexpected results, and at most would simply represent a known alternative

1 to one of skill in the art. See *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 414-17 (2007). Indeed, the
 2 Supreme Court held that a person of ordinary skill in the art is “a person of ordinary creativity, not an
 3 automaton,” and “in many cases a person of ordinary skill in the art will be able to fit the teachings of
 4 multiple patents together like pieces of a puzzle.” *Id.* at 420.

5 **1. The Nature of the Problem Being Solved**

6 For example, a person of ordinary skill in the art would have been motivated to combine or
 7 modify the prior art (including to form the specific exemplary combinations identified above in
 8 Section III.A) based on the nature of the problem being solved, e.g., the problem of protecting a
 9 network from unauthorized access. To the extent additional relevant sources—such as the Asserted
 10 Patents, the prosecution history, or testimony or documents provided by named inventors or
 11 companies involved in the development of the technology described in the Asserted Patents—
 12 identify additional problems that were allegedly being solved, Forescout reserves the right to rely on
 13 such problems that were allegedly being solved.

14 **2. The Express, Implied and Inherent Teachings of the Prior Art**

15 As another example, a person of ordinary skill would have been motivated to combine or
 16 modify the disclosed prior art (including to form the exemplary combinations identified above in
 17 Section III.A) based on the express, implied and inherent teachings of the prior art, e.g., the benefits
 18 of protecting a network from unauthorized access. Forescout also incorporates its claim charts (which
 19 specifically compare the teachings of the prior art to the limitations of the Asserted Claims) by
 20 reference. To the extent the prior art, including the prior art identified throughout these Invalidity
 21 Contentions, provides additional teachings, Forescout reserves the right to rely on such teachings.
 22 Additionally, Forescout reserves the right to rely on passages from the prior art beyond those explicitly
 23 quoted or cited below.

24 **3. The Knowledge of Persons of Ordinary Skill in the Art**

25 As another example, a person of ordinary skill in the art would have been motivated to combine
 26 or modify any of the disclosed prior art (including to form the specific exemplary combinations
 27 identified above in Section III.A) because it was within such person's knowledge to combine or modify
 28 the prior art to include various features omitted from any single prior art reference or combination of

1 references. Such features include, but are not limited to, the following: using a device's identity and
 2 location, directing a user to an agent, ongoing monitoring of a network, using a VPN concentrator,
 3 considering regulatory compliance, using scan policies, using dynamically applied firewall rules,
 4 managing roles, automatic remediation, detecting IP, port, and identifier to determine endpoint type,
 5 detecting, identifying, and categorizing network endpoints, allowing devices on a network without
 6 sponsor intervention, using time-based permissions, storing identifiers, creating guest accounts,
 7 limiting network access, or storing network parameters and identifiers in a database.

8 **4. The Predictable Results Obtained in Combining the Different Elements of**
the Prior Art According to Known Methods

10 As another example, a person of ordinary skill in the art would have been motivated to form
 11 combinations based on any of the disclosed prior art to include features omitted from any single prior
 12 art reference or combination of references because doing so would have generated predictable results
 13 and could have been accomplished according to known methods. Such features include, but are not
 14 limited to, each of the features identified in Section III.B.3., above.

15 **5. The Predictable Results Obtained in Simple Substitution of One Known**
Element for Another

17 As another example, a person of ordinary skill in the art would have been motivated to combine
 18 or modify the prior art (including to form the specific exemplary combinations identified above in
 19 Section III.A) because doing so would have involved substituting one feature for another feature
 20 known in the art and would have generated predictable results. Such features that could have been
 21 added by substitution include, but are not limited to, each of the features identified in Section III.B.3.,
 22 above.

23 **6. The Use of a Known Technique to Improve Similar Devices, Methods, or**
Products in the Same Way

25 As another example, a person of ordinary skill in the art would have been motivated to combine
 26 or modify the prior art (including to form the specific exemplary combinations identified above in
 27 Section III.A) because doing so would have used known features to improve similar devices, methods,
 28 or products (including but not limited to devices, methods, or products in or related to the field of

1 network access control) in the same way, and would have generated predictable results. Such features
 2 include, but are not limited to, each of the features identified in Section III.B.3., above.

3 **7. The Predictable Results Obtained in Applying a Known Technique to a**
 4 **Known Device, Method, or Product Ready for Improvement**

5 As another example, a person of ordinary skill in the art would have been motivated to combine
 6 or modify the prior art (including to form the specific exemplary combinations identified above in
 7 Section III.A) because doing so would have involved applying a known technique to improve a known
 8 device, method, or product (including but not limited to devices, methods, or products in or related to
 9 the field of network access control), and would have generated predictable results. Such features
 10 include, but are not limited to, each of the features identified in Section III.B.3., above.

11 **8. The Finite Number of Identified Predictable Solutions that Had a**
 12 **Reasonable Expectation of Success**

13 As another example, a person of ordinary skill in the art would have been motivated to combine
 14 or modify the prior art (including to form the specific exemplary combinations identified above in
 15 Section III.A) because doing so would have been obvious to try. Specifically, a person of ordinary
 16 skill in the art would have recognized that, within the field of network access control (for example),
 17 there were a finite number of identified, predictable potential features that could solve a recognized
 18 need or problem, and a person of ordinary skill in the art would have pursued incorporating these
 19 known features with a reasonable expectation of success. Such features include, but are not limited
 20 to, each of the features identified in Section III.B.3., above.

21 **9. Known Work in Various Technological Fields that Could Be Applied to**
 22 **the Same or Different Technological Fields Based on Design Incentives or**
 Other Market Forces

23 As another example, a person of ordinary skill in the art would have been motivated to combine
 24 or modify the prior art (including to form the specific exemplary combinations identified above in
 25 Section III.A), including the prior art references, which are in the same field of the Asserted Patents
 26 and each other (such as network access control), or in a different field, to include various features
 27 because doing so would have been prompted by design incentives or market forces, variations or
 28 principles applying such features that were known in the prior art, and doing so would have generated

1 predictable results. Such design incentives or market forces include, but are not limited to, those
 2 identified by the Asserted Patents themselves and the prior art (discussed above in Sections III.B.1–
 3 III.B.8). Such features include, but are not limited to, each of the features identified in Section III.B.3.,
 4 above.

5 **IV. P.R. 3-3(c): CLAIM CHARTS**

6 Pursuant to Local P.R. 3-3(c), and subject to Forescout’s reservation of rights contained herein,
 7 the invalidity claim charts, attached hereto as Exhibits A-1–A-7, B-1–B-4, and C-1–C-5, identify
 8 where in each item of prior art each element of each asserted claim is found for the Asserted Claims.

9 The cited portions of the prior art references are examples and representative of the content of
 10 the prior art references, and should be understood in the context of the reference as a whole, as
 11 understood by one of ordinary skill in the art. To the extent any cited prior art reference fails to
 12 explicitly teach or suggest one or more limitations of that claim, the limitation would nonetheless have
 13 been inherent in and/or implied by the reference and/or obvious to one of ordinary skill in the art at
 14 the time of the alleged invention(s), either alone or by the combination of the cited prior art references
 15 with any of the other listed references and/or common knowledge disclosing the missing claim
 16 limitations. Non-limiting examples of certain combinations are outlined above. It should be
 17 understood that citations within each exhibit are exemplary, not exhaustive, and should not be
 18 construed as the sole evidentiary support in the reference.

19 **V. P.R. 3-3(d): INVALIDITY BASED ON SECTION 101, INDEFINITENESS, LACK OF 20 ENABLEMENT, AND LACK OF WRITTEN DESCRIPTION**

21 Pursuant to Local P.R. 3-3(d), and subject to Forescout’s reservation of rights, Forescout
 22 includes below the grounds on which Forescout contends the Asserted Claims are invalid based on 35
 23 U.S.C. § 101, indefiniteness, lack of written description, and/or lack of enablement under pre-AIA 35
 24 U.S.C. § 112.

25 As noted above, Fortinet has not yet provided a claim construction for any of the terms and
 26 phrases that Forescout anticipates will be in dispute. Forescout, therefore, cannot provide a complete
 27 list of its indefiniteness, lack of written description, and lack of enablement defenses because
 28 Forescout does not know whether Fortinet will proffer a construction for certain terms and phrases

1 that would be broader than, or inconsistent with, a construction supportable by the disclosure set forth
 2 in the specification. Accordingly, Forescout reserves the right, to the extent permitted by the Court
 3 and the applicable statutes and rules, to supplement, amend, and/or modify these indefiniteness, lack
 4 of written description, and lack of enablement defenses as discovery progresses and in accordance
 5 with Fortinet's claim construction, infringement and validity disclosures.

6 **A. Section 101**

7 Each and every asserted claim of the '299, '314, and '662 Patents are invalid as patent-
 8 ineligible under 35 U.S.C. § 101. Forescout incorporates by reference its briefing and argument
 9 relating to its Motion to Dismiss. *See* Dkt. Nos. 24, 28, and 45. Fortinet has not identified any factual
 10 issue or potential claim construction that would preclude judgment as a matter of law regarding the
 11 § 101 defense, and Forescout contends there is none. To the extent Fortinet (or the Court) identifies
 12 any such issue, Forescout reserves the right to amend this contention to address such factual issue or
 13 claim construction.

14 **B. Indefiniteness**

15 Pre-AIA 35 U.S.C. § 112, ¶ 2 contains two requirements: "first, [the claim] must set forth what
 16 the applicant regards as his invention and second, it must do so with sufficient particularity and
 17 distinctness, i.e., the claim must be sufficiently definite." *Allen Eng'g Corp. v. Bartell Indus., Inc.*,
 18 299 F.3d 1336, 1348 (Fed. Cir. 2002) (internal quotes removed) (quoting *Solomon v. Kimberly-Clark*
 19 *Corp.*, 216 F.3d 1372, 1377 (Fed. Cir. 2000)); *see also Justacomm-Texas Software, LLC, v. Axway,*
 20 *Inc.*, Case No. 6:10-cv-00011-LED, Dkt. No. 1079 at 6 (E.D. Tex. July 5, 2012). "A determination of
 21 whether a claim recites the subject matter which the applicant regards as his invention and is
 22 sufficiently definite, so as to satisfy the requirements of 35 U.S.C. § 112, ¶ 2, is a legal
 23 conclusion . . ." *Allen Eng'g*, 299 F.3d at 1343. Under the first requirement of pre-AIA § 112, ¶ 2,
 24 a court must hold a claim invalid "[w]here it would be apparent to one of skill in the art, based on the
 25 specification, that the invention set forth in [the] claim is not what the patentee regarded as his
 26 invention." *Id.* at 1349. Under the second requirement of pre-AIA § 112, ¶ 2 and post-AIA § 112(b),
 27 a claim is sufficiently definite only if, viewed in light of the specification and prosecution history, it
 28 informs those skilled in the art about the scope of the invention with reasonable certainty. *Nautilus*,

1 *Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898 (2014).

2 Various Asserted Claims identified below do not comply with the requirements of pre-AIA 35
 3 U.S.C. § 112, ¶ 2, for failing to particularly point out and distinctly claim “the subject matter which
 4 the applicant regards as his invention” for the following reasons. For example, as demonstrated either
 5 individually or collectively by the claim elements addressed below, various Asserted Claims fail to
 6 inform those skilled in the art about the scope of the invention with reasonable certainty, rendering
 7 those claims (and any claims depending therefrom) invalid as indefinite.¹ The following chart
 8 identifies the claims in which the identified terms and phrases explicitly appear, although those
 9 identified terms and phrases are also incorporated into additional dependent Asserted Claims.
 10 Forescout’s contentions as to indefiniteness also include those dependent claims. Additionally, to the
 11 extent any Asserted Claim containing the identified limitations or phrases or substantially identical
 12 limitations or phrases is not specifically identified in the table below, Forescout still identifies such a
 13 claim based on its inclusion of such term or phrase.

<u>Patent</u>	<u>Claim(s)</u>	<u>Indefinite Term and/or Phrase</u>
'299	1, 11	“communicating with said RAD to make real-time changes to its running configuration”
'299	1, 11	“said enforcement is vendor-independent”
'299	1, 3, 4, 8	“said network access”
'299	1, 5	“said network access control”
'299	1	“said out of band network control”
'299	1, 11	“said client device”
'299	1, 11	“said agent identifying client to said NACS” / “identifying client to said NACS by said agent”
'299	3	“The system of claim 1, wherein said network access comprises: a VPN concentrator that is said RAD”

26
 27 ¹ Forescout’s analysis is preliminary, and Forescout reserves the right to assert claim constructions
 28 other than “indefinite” for each of the terms identified below.

<u>Patent</u>	<u>Claim(s)</u>	<u>Indefinite Term and/or Phrase</u>
'299	8	“The system of claim 5, wherein said network access of said connecting user device is controlled by filters based on identity and location of connecting user and said RAD.”
'299	11	“said system”
'314	1, 15, 20	“using said templates assigned to said sponsor by said network administrator”
'314	1	“said sponsors not having network management administrative privileges over said network administrator”
'314	9	“The method of claim 8, wherein said template is a guest template comprising”
'314	11	“The method of claim 1, wherein endpoint control delegation comprises”
'314	12	“The method of claim 1, wherein temporary network users (TNUs) are categorized based on template used to create said TNUs' accounts in an access control database of said network, wherein association with said TNU template remains after said account is created.”
'314	20	“at least one microprocessor executing instructions delegating, by said network administrator, network management administrative privileges to said network sponsor”

The above limitations of the Asserted Claims, even when read in light of the specification and prosecution history, fail to inform with reasonable certainty one of ordinary skill in the art about the scope of the invention. For example, to one skilled in the art, at least the terms identified as part of Category 1 are not adequately defined in the common specification for the Asserted Patents. Their lack of reasonably ascertainable scope is compounded by Fortinet's overbroad and vague infringement contentions. Thus, the Asserted Claims fail to distinctly claim the subject matter that the applicant regards as the invention and are invalid under the second paragraph of pre-AIA 35 U.S.C. § 112. *See Nautilus*, 572 U.S. at 907–911.

C. Lack of Written Description, Lack of Enablement

Various Asserted Claims are invalid for failure to comply with the written description requirement under pre-AIA 35 U.S.C. § 112, ¶ 1. To satisfy the written description requirement, the description must “clearly allow persons of ordinary skill in the art to recognize that [the inventor]

1 invented what is claimed.” *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010). In other words, the test for sufficiency is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date. *Id.*

5 Various Asserted Claims are invalid for failure to comply with the enablement requirement
 6 under pre-AIA 35 U.S.C. § 112, ¶ 1. To satisfy the enablement requirement of 35 U.S.C. § 112, ¶ 1,
 7 the disclosure “must teach those skilled in the art how to make and use the full scope of the claimed
 8 invention without ‘undue experimentation.’” *Sitrick v. Dreamworks, LLC*, 516 F.3d 993, 999 (Fed.
 9 Cir. 2008). Moreover, “[i]t is the specification, not the knowledge of one skilled in the art that must
 10 supply the novel aspects of the invention in order to constitute adequate enablement.” *Genentech, Inc.*
 11 v. *Novo Nordisk A/S*, 108 F.3d 1361, 1366 (Fed. Cir. 1997). The Federal Circuit has enumerated
 12 several factors to consider in determining whether a disclosure would require “undue
 13 experimentation”: (1) the quantity of experimentation necessary; (2) the amount of direction or
 14 guidance presented; (3) the presence or absence of working examples; (4) the nature of the invention;
 15 (5) the state of the prior art; (6) the relative skill of those in the art; (7) the predictability or
 16 unpredictability of the art; and (8) the breadth of the claims. *In re Wands*, 858 F.2d 731, 737 (Fed.
 17 Cir. 1988).

18 Various Asserted Claims identified below do not comply with the requirements of pre-AIA 35
 19 U.S.C. § 112, ¶ 1, for failing to satisfy the written description or enablement requirements. For
 20 example, as demonstrated either individually or collectively by the claim elements addressed below,
 21 the specification fails to convey that the inventor had possession of that subject matter and the
 22 specification fails to teach how to make and use the full scope of the invention without undue
 23 experimentation. The following chart identifies the claims in which the identified terms and phrases
 24 explicitly appear, although those identified terms and phrases are also incorporated into additional
 25 dependent Asserted Claims. Forescout’s contentions as to written description and enablement also
 26 include those dependent claims. Additionally, to the extent any Asserted Claim containing the
 27 identified limitations or phrases or substantially identical limitations or phrases is not specifically
 28 identified in the table below, Forescout still identifies such a claim based on its inclusion of such term

1 or phrase.

<u>Patent</u>	<u>Claim(s)</u>	<u>Term and/or Phrase Lacking Written Description and/or Enablement</u>
'299	1	"endpoint compliance of said connections"
'299	1	"usage policy enforcement of said connections"
'299	1, 11	"wherein said enforcement is out of band and is accomplished on said RAD, comprising communicating with said RAD to make real-time changes to its running configuration, whereby said enforcement is vendor-independent and said system is RAD-agnostic" / "wherein said enforcement is out of band and is accomplished on said RAD, comprising communicating with said RAD to make real-time changes to its running configuration, whereby said enforcement is vendor-independent and said system is RAD-agnostic"
'299	1, 11	"said RAD directing said client device to an agent; on said user device, running said agent; said agent identifying client to said NACS" / "directing said client device to an agent by said RAD; running said agent on said user device; identifying client to said NACS by said agent"
'299	3	"The system of claim 1, wherein said network access comprises: a VPN concentrator that is said RAD"
'299	4	"The system of claim 1, wherein said network access comprises a connection attempt comprising constructing a connection model from information about user and said RAD."
'299	10	"wherein said usage policy enforcement comprises data recording whereby security threat analysis and regulatory compliance reports are generated, and at-risk device access comprises an automatic remediation option"
'299	19	"wherein said NAF comprises dynamically applied firewall rules based on assigned IP network address"
'314	1	"creating templates for users and devices of said computer network by said network administrator at an administrator account on a workstation connected to said computer network"
'314	1, 15, 20	"transferring responsibility for said users and devices from said network administrator to said sponsor when said template of said users and devices is associated with said profile of said sponsor" / "transferring responsibility for said endpoint from said network administrator to said sponsor when said template of said endpoint is associated with said profile of said sponsor" / "transferring responsibility for said endpoint from said network administrator to said network sponsor when said template of said endpoint is associated with said profile of said sponsor record of said network sponsor"

<u>Patent</u>	<u>Claim(s)</u>	<u>Term and/or Phrase Lacking Written Description and/or Enablement</u>
'314	3, 17	"defining whether said sponsor can manually register profiled devices" / "identifying if said sponsor can manually register profiled devices"
'314	9	"The method of claim 8, wherein said template is a guest template comprising: time period that guest user can access said network; role said guest user will be assigned, whereby access to said network is limited; scan policy to enforce compliance of guest's system before allowed on said network; and authentication method to determine how said guest will authenticate to said network."
'314	12	"The method of claim 1, wherein temporary network users (TNUs) are categorized based on template used to create said TNUs' accounts in an access control database of said network, wherein association with said TNU template remains after said account is created."
'314	16	"The system of claim 15, wherein template rules are created to automatically allow devices on said network with no intervention by said sponsor."
'314	18	"said sponsor profile enabling said sponsor to view devices managed by said sponsor"

VI. DISCLOSURES AND PRODUCTION

Alongside these contentions, Forescout makes a production in compliance with the Patent Local Rules of this District.

A. Technical Documents

Forescout produces technical documents showing the operation of the Accused Products in accordance with Patent Local Rule 3-4(a) at FORESCOUT00000001–7690. Discovery is ongoing, and Forescout reserves the right to supplement this production as additional information is discovered in accordance with the Local Rules of this District, the Federal Rules, and any other applicable statutes or rules.

B. Prior Art Documents

Forescout produces prior art documents, including the above cited prior art patents and publications, in accordance with Patent Local Rule 3-4(b) at FORESCOUT00007691–11267. Discovery is ongoing, and Forescout reserves the right to supplement this production as additional information is discovered in accordance with the Local Rules of this District, the Federal Rules, and

1 any other applicable statutes or rules.

2 **C. Comparable Agreements and Agreements Supporting Damages Case**

3 Forescout produces agreements in accordance with Patent Local Rule 3-4(c) and 3-4(e) that it
4 may rely on in connection with its damages case at FORESCOUT00011268–11322. The agreement
5 at FORESCOUT00011294–301 is subject to a notice requirement and cannot yet be produced.
6 Forescout expects to produce that agreement on October 26, 2020 barring any objection by the third
7 party to the production of that agreement. This production should not be taken as an admission that
8 any such agreement is comparable. Forescout will disclose its damages contentions in compliance
9 with the local rules. Discovery is ongoing, and Forescout reserves the right to supplement this
10 production as additional information is discovered in accordance with the Local Rules of this District,
11 the Federal Rules, and any other applicable statutes or rules.

12 **D. Financial Documents**

13 Forescout produces financial information in accordance with Patent Local Rule 3-4(d) at
14 FORESCOUT00011323. Discovery is ongoing, and Forescout reserves the right to supplement this
15 production as additional information is discovered in accordance with the Local Rules of this District,
16 the Federal Rules, and any other applicable statutes or rules.

17

18 Dated: October 12, 2020

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CERTIFICATE OF SERVICE

I am employed in the City and County of San Mateo, State of California. I am over the age of 18 and not a party to the within action; my business address is Winston & Strawn LLP, 275 Middlefield Road, Suite 205, Menlo Park, CA 94025.

On October 12, 2020, I caused to be served the following documents described as:

FORESCOUT TECHNOLOGIES, INC. INVALIDITY CONTENTIONS

on the interested parties in this action listed on the service list below.

 by electronically transmitting a true and correct copy thereof via e-mail to the following, in accordance with their agreement to be served electronically pursuant to Federal Rule of Civil Procedure 5(b)(2)(E). No error messages were received after said transmission.

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I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed on October 12, 2020 at Foster City, California.

Liberty Quan